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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,130	11/12/1999	AKIRA SAKAGUCHI	JA9-98-217	1265

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EXAMINER

BURGESS, BARBARA N

ART UNIT PAPER NUMBER

2157

DATE MAILED: 07/02/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/439,130

Applicant(s)

SAKAGUCHI, AKIRA

Examiner

Barbara N Burgess

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on April 15, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action is in response to amendments filed on April 15, 2003. Claims 1-11 are presented for further examination.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1- are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota et al. (hereinafter "Shiota", 6,337,712).

As per claims 1-3, 5, 7-10, Shiota discloses:

- Generating an image file in response to specifying image data by an operator of said client terminal (column 2, lines 36-37, 43-46, 64-67, column 3, lines 1-3, column 4, lines 25-26, Figure 1);
- Acquiring an image file name from said server (column 3, lines 29-41, column 5, lines 62-67, column 6, lines 1-30);
- Converting said image file to generate a predetermined formed compressed image data which has a file name relating to said unique image file name (column 5, lines 42-67);
- Sending said predetermined formed compressed image data to said server (column 2, lines 41-47, 65-67, column 3, lines 1-3, column 4, lines 20-30, column 5, lines 56-60, column 6, lines 8-9);
- Displaying said predetermined formed compressed image data of said server on a Web browser on said client terminal (column 2, lines 53-59, column 3, lines 9-28, column 4, lines 21-30, column 6, lines 31-47, column 7, lines 44-57);
- Posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal (column 2, lines 53-59, column 3, lines 9-41, column 4, lines 21-30, column 5, lines 62-67, column 6, lines 1-47, column 7, lines 44-57).

As per claims 4, 6, and 11, Shiota discloses a method of communicating on a communication system comprising:

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- A client terminal connecting with a network and a server connecting with said network (column 2, lines 36-37, 43-46, 64-67, column 3, lines 1-3, column 4, lines 25-26, Figure 1);
- Storing a file created by an operator of said client terminal which has a name capable of determining that it was created by said operator (column 2, lines 36-37, 43-46, 64-67, column 3, lines 1-3, 29-41, column 4, lines 25-26, column 5, lines 62-67, column 6, lines 1-30, Figure 1);
- Receiving a message sent from the client terminal including information capable of identifying said operator (column 3, lines 29-41, column 5, lines 62-67, column 6, lines 1-30);
- Acquiring the information capable of identifying said operator included in said message (column 3, lines 29-41, column 5, lines 62-67, column 6, lines 1-30);
- Generating a file list file by inserting said file name into a skeleton file (column 3, lines 29-41, column 5, lines 62-67, column 6, lines 1-30).

***Response to Arguments***

The Office notes the following arguments:

- (a) Katsurabayashi does not teach or suggest, "sending said predetermined formed compressed image data to said server".
- (b) Peterson fails to teach or suggest, "posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal.
- (c) There is no teaching that such an image is created by the operator making the request.
- (d) Hunt also fails to teach or suggest "posting the file name of said file list to said client terminal.
- (e) Blumer does not teach or suggest "acquiring the file name of the file created by said operator based on said information capable of identifying said operator.

In response to:

- (a)-(e) Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Ettinene can be reached on (703) 308-7265. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess  
Examiner  
Art Unit 2153

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June 26, 2003

  
ARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

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